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APPLICATION NO.	FILING DATE	FIRST NAMED-INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/315,034	05/20/1999	NAOTO KINJO	1110-0237P	5934
2292	7590	04/21/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			ROGERS, SCOTT A	
			ART UNIT	PAPER NUMBER
			2626	
DATE MAILED: 04/21/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/315,034

Applicant(s)

KINJO, NAOTO

Examiner

Scott A Rogers

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-12, 14-22, 24-26, 28-58 and 65-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10, 11, 24, 25, 31-48 and 65-81 is/are allowed.
- 6) ☒ Claim(s) 1-7, 12, 14, 17, 19-22, 26, 28, 49-53 and 55-58 is/are rejected.
- 7) ☒ Claim(s) 8, 15, 16, 18, 29, 30, 54, 67 and 68 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments on pages 51-61 of the response filed 28 January 2004, with respect to the group of claims 10-11, 24-25, 31-40, and 67 and the group of claims 41-45, 65-66, and 68-79, have been fully considered and are persuasive. The rejections of these claims have been withdrawn.

Applicant's arguments filed 28 January 2004 have been fully considered but they are not persuasive with respect to claims 1-7, 12, 14, 17, 19-22, 26, 28, 49-53, and 55-58. See the following new rejection. In regard to applicant's arguments with respect to the rejected claims, please note the alternative claim language used by Applicant when reading the claims on the applied references as recited below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 12, 17, 19-22, 26, 49-51, and 55-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art in view of Yamada et al (US 5689326).

Referring to claims 1-2:

The "digital photoprinter" admitted by applicant (see page 2, line 5 to page 5, line 15) acquires digital image data of a photographed image of a subject in order to obtain output image data, by subjecting the digital image data to preset image processing, and outputs a visible image reproducing the photographed image based on the output image data, wherein (referring to claim 2) the digital image data is digital image data obtained by photoelectrically reading the photographed image of the subject on a photographic film (e.g., by using a film scanner) or digital image data of the photographed image obtained directly by photographing the subject (e.g., by using a digital camera).

While not disclosed in the admitted prior art, Yamada et al disclose that photographing information in association with the photographed image and supplementary information relating to at least a part of the photographing information are captured by a camera (col. 8, line 67 to col. 9, line 9). The captured photographing information includes information of the photographing location (site) and photographing direction (angle). While not disclosed in the admitted prior art, Yamada et al further disclose reproducing and adding the captured supplementary information to the photographed image (col. 9, lines 14-17).

Referring to claim 3:

In addition to claim 1, Yamada et al further outputs the visible image by display on a monitor (col. 5, lines 51-53).

Referring to claim 4:

In addition to claim 1, Yamada et al further disclose that the supplementary information is information with respect to the subject of the photographed image or a photographing situation of the photographed image (col. 9, lines 1-9).

Referring to claims 5 and 17:

In addition to claim 1, Yamada et al further disclose that the supplementary information is character data (col. 8, lines 10-11).

Referring to claim 6:

In addition to claim 1, Yamada et al further disclose output of the visible image on a photographic print and display of the visible image on a display means, wherein the supplementary information is composited to the visible image on the photographic print and the displayed visible image on the display means, displayed as characters (col. 5, lines 51-53, col. 8, lines 10-11, and col. 9, lines 14-17).

Referring to claim 7:

In addition to claim 1, Yamada et al further disclose that the photographing information and the supplementary information is recorded to a magnetic recording layer of a photographic film which corresponds to a photographing frame of the photographic film to which the photographed image is photographed, said at least one of the photographing information or the supplementary information is read out from the

magnetic recording layer, when the image of said photographing frame is reproduced as the visible image, and the supplementary information captured from the read out photographing information or the read out supplementary information is output by being added to a photographed image of said photographing frame (col. 8, line 63 to col. 9, line 17).

Referring to claim 12:

Claim 12 corresponds to claim 1 verbatim but includes the additional limitation requiring that the photographing information is at least a part of a photographing date and time data which is captured in association with the photographed image. This feature is disclosed in Yamada (col. 9, line 3).

Referring to claim 49-51:

The "digital photoprinter" admitted by applicant (see page 2, line 5 to page 5, line 15) obtains digital image data of an image of a photographing frame, to which an image subject is photographed, of an image recording medium, obtains output image data by subjecting the obtained digital image data to preset image processing, and outputs at least one of a photographic print and a displayed image based on the output image data, wherein (referring to claim 50) the image recording medium is a photographic film, and the digital image data is obtained by photoelectrically reading the image of a photographing frame photographed to the photograph film (e.g., by using a film scanner), or (referring to claim 51) the image recording medium is a digital recording medium, and the digital image data is directly recorded to the digital data recording

medium by being photographed with a digital photographing device and then read from the digital data recording medium (e.g., by using a digital camera).

While not disclosed in the admitted prior art, Yamada et al disclose that photographing information in association with the photographed image and supplementary information relating to at least a part of the photographing information are captured by a camera (col. 8, line 67 to col. 9, line 9). The captured photographing information includes information of the photographing location (site) and photographing direction (angle). While not disclosed in the admitted prior art, Yamada et al further disclose adding the captured supplementary information to at least one of the photographic print and the displayed image (col. 5, lines 51-53 and col. 9, lines 14-17).

It would have been obvious to one of ordinary skill in the art to have incorporated the teachings of Yamada et al as referred to above into the admitted prior art digital photoprinter in order to form prints with composited supplementary information in selected regions of reproduced images with good print balance and a high quality impression (note background & summary in Yamada et al).

Referring to claims 19-22:

Claims 19-22 are the apparatus claims corresponding to method claims 1-8 above and are rejected for the same reasons since the applied art has the corresponding means to perform the methods steps discussed with respect to the cited passages.

Referring to claim 26:

Claim 26 is the apparatus claim corresponding to method claim 12 above and is rejected for the same reasons since the applied art has the corresponding means to perform the methods steps discussed with respect to the cited passages.

Referring to claims 55-57:

Claims 55-57 are the apparatus claims corresponding to method claims 49-51 above and are rejected for the same reasons since the applied art has the corresponding means to perform the methods steps discussed with respect to the cited passages.

Claims 14 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art in view of Yamada et al (US 5689326) as applied to claims 49 and 55 above, and further in view of Fukutani et al (JP 8-240854).

Referring to claim 14:

While not disclosed in the admitted prior art, Fukutani et al disclose that it is known in the prior art to capture photographing location information using a satellite based position measuring device, such as GPS, and to record this information as photographing condition information together with the photographed image (see partial translated by applicant).

It would have been obvious to one of ordinary skill in the art to have incorporated the teachings in Fukutani et al referred to above into the combination of the admitted prior art digital photoprinter and Yamada et al in order to form prints with map data

allowing easy identification of the location where the associated image was photographed.

Referring to claim 28:

Claim 28 is the apparatus claim corresponding to method claim 14 above and is rejected for the same reasons since the applied art has the corresponding means to perform the methods steps discussed with respect to the cited passages.

Claims 52 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art in view of Yamada et al (US 5689326) as applied to claims 49 and 55 above, and further in view of Kinjo et al (US 5467168).

Referring to claim 52:

While not disclosed in the admitted prior art, Kinjo et al disclose determining the similarity between respective photographing frames based on the photographing information and subjecting the image data of a plurality of similar frames which are determined to have similarity to similar image processing so that the qualities of the images reproduced from a plurality of the similar frames are made identical (col. 4, line 59 to col. 5, line 63).

It would have been obvious to one of ordinary skill in the art to have incorporated the teachings in Kinjo et al as referred to above into a admitted prior art digital photoprinter in order to form prints with proper density and color.

Referring to claim 58:

This is the apparatus claim corresponding to method claim 52 above and is rejected for the same reasons since the applied art has the corresponding means to

Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art in view of Yamada et al as applied to claim 49 above, and further in view of additional admitted prior art.

Referring to claim 53:

While Yamada et al disclose an image recording medium having a photographing image recording region and a supplementary information recording region used as the image recording medium, the admitted prior art referred to above in combination with Yamada et al do not disclose that when supplementary information is recorded to the supplementary information recording region, the supplementary information is reproduced with a camera on which the image recording medium is mounted and the image recorded to the photographing image recording region is output, the supplementary information recorded to the supplementary information recording region being automatically or selectively recorded to at least one of the front surface and the back surface of a photographic print, a displayed image output on display means or both.

However, in the additional admitted prior art (page 12, line 5 to page 13, line 6), the "Advanced Photo System" (APS) is a prior art system wherein an image recording medium having a photographing image recording region and a supplementary information recording region is further used as the image recording medium, and when

supplementary information is recorded to the supplementary information recording region, the supplementary information is reproduced with a camera on which the image recording medium is mounted and the image recorded to the photographing image recording region is output, the supplementary information recorded to the supplementary information recording region is automatically or selectively recorded to at least one of the front surface and the back surface of a photographic print, a displayed image output on display means or both.

It would have been obvious to one of ordinary skill in the art to have modified the combination of the admitted prior art and Yamada et al as discussed above, in view of the additional admitted prior art (the APS), in order to allow the digital photoprinter to print supplementary information selectively to the front or back surface of the photographic print thereby providing improved quality and added value to the user.

Allowable Subject Matter

Claims 10-11, 24-25, 31-40, and 67 are allowed in view of respective argument made by applicant on pages 51-59 of the response filed 28 January 2004.

Claims 41-45, 65-66, and 68-79 are allowed in view of respective argument made by applicant on pages 60-61 of the response filed 28 January 2004.

Claims 46-48 and 80-81 are allowed as previously indicated.

Claims 8, 15, 16, 18, 29, 30, and 54 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Objections

The following quotations of 37 CFR § 1.75(a) is the basis of objection:

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

Claims 15 and 67-68 are objected to under 37 CFR § 1.75(a) as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention or discovery.

In method claim 15, on the last 2 lines, the language "information from the supplementary information stored in a database beforehand" should be edited and inserted earlier in the claim similar to how the corresponding apparatus claim 29 was drafted.

In claim 67, lines 2-4 are poorly and the required grammatical correction should be obvious to Applicant.

In claim 68, the language on the last 2 lines is confusing and should be corrected.

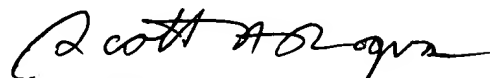
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott A Rogers whose telephone number is 703-305-4726. The examiner can normally be reached on Monday-Thursday 6:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on 305-4863.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at 703-306-0377. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

19 April 2004



SCOTT ROGERS
PRIMARY EXAMINER